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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,049	12/30/2003	David B. Olson	58907US002	6791
32692	7590	08/30/2006		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER BERNSHTEYN, MICHAEL	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 08/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/748,049	Applicant(s) OLSON ET AL.	
	Examiner Michael Bernshteyn	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/08/2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-22 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-13 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 8, 2006 has been entered.
2. This Office Action is being provided in reply to the amendment accompanying the foregoing RCE. Applicants have amended claims 1 and 19, claim 8 has been cancelled.
3. Due to Terminal Disclaimer under 37 CFR 1.321, the double patenting rejection has been withdrawn.
4. Claims 1-7, 9-13 and 19 are active.

### ***Claim Rejections - 35 USC § 103***

5. The test of this section of Title 35, U.S.C. not included in this action can be found in a prior Office Action.
6. Claims 1-7, 9-13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson et al. (U.S. Patent 6,261,700) in view of Williams et al. (U.S.

Patent 5,626,800), for rationale recited in paragraph 4 of Office Action dated on July 19, 2006, and comments below.

### ***Response to Arguments***

7. Applicants traverse the rejection under 35 U.S.C. § 103(a) of claims 1-7, 9-13 and 19 as being unpatentable over Olson et al. (U. S. Patent 6,261,700) in view of Williams et al. (U.S. Patent 5,855,983) in view of the amended claims 1 and 19.

Applicant's arguments have been fully considered but they are not persuasive.

8. Applicants contend that each of the independent claims 1 and 19 has been amended to recite 5 to 30 wt.% of a crosslinking agent. Applicants submits that even if they were some motivation to employ the creamer surface coating of Olson et al. in the prism structure of Williams et al., the combination of Olson et al and Williams et al. does not meet all the claim limitations since neither reference teach the particular composition presently being claimed (page 7, 1<sup>st</sup> paragraph).

9. It is noted that Olson discloses all the compounds of instantly claimed composition as it was mentioned in details in the previous Office Action. Additionally, with regard to the amended claims 1 and 19, Olson discloses that particularly preferred multifunctional ester (meth)acrylic acids can comprise a mixture of di-, tri-, and tetra(meth)acrylate esters of **pentaerythritol** (col. 12, line 39 through col. 13, line 13). **Pentaerythritol tri(meth)acrylate** is readable as a crosslinking agent c) in the claims 1 and 19.

Olson discloses that preferably the binder precursor includes both mono- and multi-functional polymerizable brominated (meth)acrylate monomer, e.g., from about 10 to 20 parts by weight monofunctional polymerizable brominated compound and from about 20 to 30 pbw difunctional polymerizable brominated compound based on 100 pbw binder precursor which is within the claimed range (col. 13, lines 25-31).

It is noted that the amount of the weight ratio of the components A and B is a result effective variable, and therefore, it is within the skill of those skilled in the art to find the optimum value of a result effective variable, as per *In re Boesch and Slaney* 205 USPQ 215 (CCPA 1980). See also *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382: "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."

10. It is noted that during the interview held on August 22, 2006, the attorney agreed to file the declaration to overcome the art rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

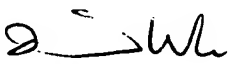
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn  
Examiner  
Art Unit 1713

MB  
08/25/2006

  
DAVID W. WU  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 1700